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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.666,152	09.20.2000	Kimiyuki Shibuya	49218-C	7703

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03.04.2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on

January 22, 2002

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

Shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, never is longer, from the mailing date of this communication. Failure to respond within the period for response will cause application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 9-18 ☒ are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
Claim(s) _____ is/are allowed.
Claim(s) 9-18 ☒ are rejected.
Claim(s) _____ is/are objected to.
Claim(s) _____ are subject to restriction or election requirement.

Specification Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)

References

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449 Paper No(s) _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

DETAILED ACTION

Claims 9-18 are pending in the application.

Election/Restrictions

Subject matter not embraced by elected Group V is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Rejections made in the previous Office Action that do not appear below have been overcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 9-12, the phrases "(except n is 1)" and "(except n=1)" are confusing. Are Applicants claiming that n is 1 and not 1 to 15 or are Applicants claiming a range within a range? Claim 11 fails to further limit claim 9 since the Het in claim 9 must be substituted but R₁, R₂ and R₃ in claim 11 can each represent hydrogen. In claim 11, the phrase "(except that R₁, R₂ and R₃, all are a hydrogen)" is confusing for reasons stated above for the phrases "(except n is 1)" and "(except n=1)".

Claim 13 does not conform to M.P.E.P. 608.01(m) since each claim must end with a period and no other periods may be used elsewhere in the claims except for abbreviations. Claim 13 does not further limit claim 12. In claim 15, the phrase "using compounds" should be changed to "by administering a compound". In claim 16, the phrase "using compounds of the formula (I'A)" should be changed to "wherein a

compound of formula (I'A) is administered". Also see claims 17 and 18 for same.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable Hirai et al. {JP 04139172}. An English translation of Hirai et al. was supplied with the previous Office Action.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim benzoxazole compounds. Hirai et al. teach benzoxazole compounds which are structurally similar to the instant claimed compounds. See in Hirai et al., for example, wherein R¹-R⁴ are each hydrogen, A is oxygen, R⁵ is hydrogen, and R⁶ is a substituted heteroaryl group (pages 1 and 2 of the Japanese patent and pages 6 and

16 of the English translation). Also see, for example, compounds 5, 9, 17, 34, 71, 72 and 77 in the Table on pages 7 and 8 of the Japanese patent.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of the prior art and the compounds instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. anti-ulcer agent). One skilled in the art would have been motivated to prepare compounds embraced by the reference genera to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds that would be useful in treating ulcers. Therefore, the

instant claimed compounds would have been suggested to one skilled in the art.

Response to Arguments

Applicants' arguments filed January 22, 2002 have been fully considered. Applicants argue that Hirai et al. neither discloses or suggest the instant invention having an alkylene linker with more than one carbon between the Y and Z group or having a substituted pyridyl group.

Applicants' arguments have been considered but have not been found persuasive. Applicants do not claim that the linker between the instant Y variable and the instant Z variable is more than 1 (see definition of the instant "n" variable of 1 to 15). Further, Hirai et al. teach substituted pyridyl at the same position as the instant Het variable. See page 8 (last paragraph) and page 9, lines 1-5 of the English translation and, specifically, compounds 71, 72 and 77 in Hirai et al. on page 8 in the Japanese patent. For all the reasons given above, the

instant claimed invention would have been suggested to one skilled in the art.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

This application contains subject matter drawn to inventions nonelected with traverse in Paper No. 4. A complete reply to the final

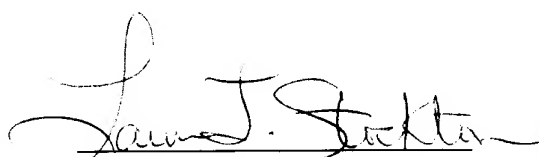
rejection must include cancellation of nonelected claims (37 CFR 1.144)

See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in cursive script, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

March 2, 2002